

Appln. No. 10/034,100

Attorney Docket No. 10541-628

**II. Remarks**

Claims 29-37 presently stand withdrawn from further consideration by Examiner as being drawn to a constructively non-elected invention. Claims 1-9, 11-16, 18, and 19 presently stand rejected on the basis of prior art. Reconsideration and further examination of this application are requested.

***Traversal of Restriction Requirement***

The Examiner imposed a restriction to one of two groups, namely Species I, having Claims 1-9, 11-16, 18, and 19 drawn to a piston anti-rotation mechanism for a swash plate compressor assembly, and Species II, having Claims 29-37 also drawn to a piston anti-rotation mechanism for a swash plate compressor assembly. The Examiner stated that Applicants constructively elected Species I based on previous presentation of these claims for prosecution on the merits. The Examiner also stated that Species II is therefore withdrawn from consideration as being directed to a non-elected invention.

Applicants herein elect Species I having Claims 1-9, 11-16, 18, and 19, but traverse the restriction requirement. The Examiner failed to specify whether the Species were distinct or independent, and therefore Applicants will assume that the Examiner is asserting that the Species are distinct.

When inventions are distinct, the Examiner still must examine the two inventions together if the search and examination of an entire application can be made without serious burden. MPEP § 803. The Examiner has not asserted a serious burden in examining the above Species in the above Paper, but Applicants assert that no serious burden exists based on the similarity between of claim 10, 20, and 28 of the application as filed and claims 29-37. Claims 10, 20, and 28 in the original application as filed (now cancelled) recited a skirt with a planar outer surface integrally connected to the arcuate outer surface having the second radius of curvature. Claims 29-37 recite a skirt having a first and a second arcuate surface defining a second radius of curvature and a planar surface located between the first and second arcuate surfaces.

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No serious burden exists with respect to an Examiner's search. Claim 1 in the original application as filed is considered a generic claim encompassing the "species" claim of current claim 1 and current claim 29 because it encompassed the subject matter of both claims. Additionally, based on the subject matter of claims 10, 20, and 28 in the original application as filed, the Examiner's initial search encompassed a search for a skirt with an arcuate outer surface. Therefore, no further search is necessary and a serious burden does not exist with respect to a search.

Additionally, no serious burden exists with respect to examination of the claims together. The Species of claims both are directed to a piston anti-rotation mechanism for a swash plate compressor assembly having at least one arcuate surface complementing a groove. Therefore, no serious burden exists with respect to examination of the claims together.

The Examiner has failed to state the reasons for insisting upon the restriction, as required by MPEP § 803. Therefore, Applicants request that these reasons be provided in a supplemental Office Action in order to fully respond to the restriction requirement.

#### **Claim Rejections – 35 U.S.C. § 103**

Responsive to the rejection of Claims 1-9, 11-16, 18, and 19 under 35 U.S.C. § 103 as being unpatentable over *Rasmussen* in view of *Kanai et al.*, Applicants assert that the combination of *Rasmussen* and *Kanai et al.* fails to provide motivation to combine the two references, and that each individual reference fails to anticipate the claims.

*Rasmussen* teaches a two-piece piston 3, 4 having an anti-rotation mechanism 5. (*Rasmussen*, col. 3, lines 51-60, Figure 2). The anti-rotation mechanism 5 prevents the piston 3, 4 from rotating along with the rotating swash plate 10. Conversely, *Kanai et al.* teach a one-piece piston 7 that does not disclose an anti-rotation mechanism 5. (*Kanai et al.* col. 3, lines 47-50, Figure 1). Therefore, there is no motivation to combine a two-piece piston having an anti-rotation mechanism with a one-piece piston lacking an anti-rotation mechanism.

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With respect to claim 1, *Rasmussen* fails to teach each and every element of a device as claimed in the present application. Claim 1 recites that the first radius of curvature is substantially constant between the first and second ends of the piston body. Contrarily, *Rasmussen* is absent any teaching of a substantially constant radius of curvature between the first end and second end of the body.

Additionally, *Kanai et al.* fail to teach each and every element of a device as claimed in the present application. Claim 1 recites an anti-rotation mechanism, and *Kanai et al.* fail to teach an anti-rotation mechanism. Therefore, claim 1 is not disclosed by *Kanai et al.*

Because *Rasmussen Kanai et al.* fail to individually teach each and every element of the claimed invention, and because there is no motivation or suggestion to combine the two references, the rejection of claim 1 under 35 U.S.C. § 103 should be withdrawn and such action is earnestly solicited.

With respect to claim 11, *Rasmussen* fails to teach each and every element of a device as claimed in the present application. Claim 11 recites that the second radius of the skirt is greater than the first radius of the body. Contrarily, *Rasmussen* is absent any teaching of a piston skirt having a radius greater than the radius of a body. Additionally, this is not a result-effective variable because a particular parameter must first be recognized as a result-effective variable by the prior art before the determination of the optimum variable range can be characterized as routine experimentation. MPEP § 2144.05, Section II, Subsection B. *Rasmussen* does not recognize that the size of the second radius is a result-effective variable, and therefore the limitation is not rendered obvious as a mere optimum range.

Additionally, *Kanai et al.* fail to teach each and every element of a device as claimed in the present application. Claim 11 recites an anti-rotation mechanism, and *Kanai et al.* fail to teach an anti-rotation mechanism. Therefore, claim 11 is not disclosed by *Kanai et al.*

Because *Rasmussen Kanai et al.* fail to individually teach each and every element of the claimed invention, and because there is no motivation or suggestion to combine the two references, the rejection of claim 11 under 35 U.S.C. § 103 should be withdrawn and such action is earnestly solicited.

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Claims 2-9 depend on claims which depend on Claim 1 and claims 12-16 and 18-19 depend on claims which depend on Claim 11. Thus, Claims 1-9, 11-16, 18, and 19 are allowable for the reasons provided above.

**Summary**

For the reasons provided above, Claims 1-9, 11-16, 18, 19, and 29-37 are properly examinable together and are in condition for allowance. Therefore, such action is earnestly solicited.

Respectfully submitted,

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Date

  
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